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WELSH & FLAXMAN LLC 2000 DUKE STREET, SUITE 100 ALEXANDRIA, VA 22314				
			EXAMINER BLAU, STEPHEN LUTHER	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/765,106

Applicant(s)

FERRIS, RICHARD D.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No.

6,723,001. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5 of U.S. Patent No. 6,723,001 have the ratio of the width to the length and a club being a putter as the only differences. The ratio is the feature which made claims 1-5 of U.S. Patent No. 6,723,001 allowable. As such it would be obvious to remove this element of structure since all ovals with have a ratio of width to length and now the claims do not require it.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11-12 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Radakovich.

Radakovich discloses a sighting device placed on a flat surface of a grip end (Fig. 4) having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line in the form of an arrow (Ref. No. 48, Fig. 5) in a direction perpendicular to a first plane of a ball striking face, a second alignment line in the form of a boundary line (Fig. 5) being perpendicular to a first alignment line, parallel to a ball striking face (Fig. 5, Col. 5, Lns. 26-39), indicia on flat surface in the form of indicia on a sticker which is placed on a butt end of a grip, a design of an arrow may be varied (Fig. 5, Col. 5, Lns. 27-33) in order to improve accuracy (Col. 1, Lns. 7-10) by improving alignment and control of a face (Col. 1, Lns. 35-37), and a grip able to be used with a putter.

Very little weight is given to the printed matter which shows the perpendicular and parallel alignment due to the mere arrangement of printed matter not being patentable subject material (See article 706.03(a) of MPEP).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-7, 9-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cacicedo in view of Bloom, Radakovich and Takeuchi.

Cacicedo discloses a hand grip having an oval shape with a front edge having a larger radius than a rear edge (Fig. 10), an upper edge and a lower edge (Fig. 17), an oval cross section shape along substantially the entire handle between an upper and lower edge (Fig. 17), and a grip cap having no vent hole (Fig. 13) in order to establish a stiffness and feel to a hand grip (Abstract).

Cacicedo lacks a putter, an oval cross section shape along the entire handle between an upper and lower edge, a length dimension being perpendicular to a first plane of a ball striking face, alignment indicia on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first alignment line, parallel to a ball striking face and intersecting a first alignment line.

Bloom discloses a putter (Fig. 4), an elongated axis of an oval, cross-sectional shape having a length being perpendicular to the plane of the ball striking face (Abstract), and an oval cross section shape along the entire handle between an upper and lower edge in order to have an ergonomic gripping surface that promotes a preferred palm and promotes proper hand and body placement (Abstract). In view of the patent of Bloom it would have been obvious to modify the club of Cacicedo to include a putter in order to utilize the advantages of establishing a stiffness and feel to a handgrip for a putter. In addition, in view of the patent of Bloom it would have been obvious to modify the club of Cacicedo to have an elongated axis of an oval along the entire handle between an upper and lower edge, cross-sectional shape having a length being perpendicular to the plane of the ball striking face in order to promote a preferred palm and promotes proper hand and body placement along handle and in order to have the same feel along the length of a grip.

Radakovich discloses a sighting device placed on a flat surface of a grip end (Fig. 4) having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first alignment line, parallel to a ball striking face and intersecting a first alignment line at a center of a grip plugging a vent hole (Col. 5, Lns. 34-39) in order to improve accuracy (Col. 1, Lns. 7-10) by improving alignment and control of a face (Col. 1, Lns. 35-37). Takeuchi discloses alignment lines for grip positioning on a shaft being on a flat surface of a grip and being indicia (Fig. 5, Col. 4, Lns. 11-16) filling up

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the entire length and width of a grip top flat surface except the center (Fig. 5). In view of the patent of Radakovich it would have been obvious to modify the putter of Cacicedo to have a sighting device placed on a flat surface of a grip end having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first alignment line, parallel to a ball striking face and intersecting a first alignment line in order to assist a golfer in improving accuracy by improving alignment and control of a face of a club. In view of the patent of Radakovich and Takeuchi it would have been obvious to modify the putter of Cacicedo to have the alignment lines being indicia and taking up the entire length, width and center of a grip top flat surface in order to minimize the number of parts needed for a grip by having indicia and in order to be more visually visible for a golfer by using the entire surface for the alignment indicia. As such for an oval shaped grip a first alignment line will be longer than a second alignment line.

7. Claims 3, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cacicedo in view of Bloom, Radakovich and Takeuchi as applied to claims 1-2, 4-7, 9-12, and 14-15 above, and further in view of Eberle or Dishner.

Cacicedo lacks a handle extending at least half of the overall length of the club from the head to the upper end of a shaft. Eberle discloses an elongated handle having a generally oval, cross-sectional shape including rounded front and rear edges (Fig. 3), an elongated axis of an oval, cross-sectional shape being perpendicular to the plane of

the ball striking face (Col. 3, Lns. 55-57), and a handle having a length approximately half the overall length of the golf club (Fig. 1) in order to have a pendulum type putter (Col. 1, Lns. 7-32). Dishner discloses an elongated handle having a generally oval, cross-sectional shape including rounded front and rear edges (Fig. 3), and a handle having a length approximately half the overall length of the golf club (Figs. 5-6) in order to have a length adaptable to a wide variance of personal stances and physiognomy (Col. 4, Lns. 13-14). In view of the patents of Eberle or Dishner it would have been obvious to modify the putter of Cacicedo to have a handle extending at least half of the overall length of the club from the head to the upper end of a shaft in order to be able to modify the stiffness and feel for a handle of a pendulum type putter and to have a length adaptable to a wide variance of personal stances and physiognomy.

8. Claims 6-7, 9-12, and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloom in view of Radakovich and Takeuchi.

Bloom discloses a putter (Fig. 4), an elongated axis of an oval, cross-sectional shape having a length being perpendicular to the plane of the ball striking face (Abstract), and an oval cross section shape along the entire handle between an upper and lower edge in order to have an ergonomic gripping surface that promotes a preferred palm and promotes proper hand and body placement (Abstract).

Boom lacks an alignment indicia on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line



being perpendicular to a first alignment line, parallel to a ball striking face and intersecting a first alignment line.

Radakovich discloses a sighting device placed on a flat surface of a grip end (Fig. 4) having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first alignment line, parallel to a ball striking face and intersecting a first alignment line at a center of a grip plugging a vent hole (Col. 5, Lns. 34-39) in order to improve accuracy (Col. 1, Lns. 7-10) by improving alignment and control of a face (Col. 1, Lns. 35-37). Takeuchi discloses alignment lines for grip positioning on a shaft being on a flat surface of a grip and being indicia (Fig. 5, Col. 4, Lns. 11-16) filling up the entire length and width of a grip top flat surface except the center (Fig. 5). In view of the patent of Radakovich it would have been obvious to modify the putter of Boom to have a sighting device placed on a flat surface of a grip end (Fig. 4) having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first alignment line, parallel to a ball striking face and intersecting a first alignment line in order to assist a golfer in improving accuracy by improving alignment and control of a face of a club. In view of the patent of Radakovich and Takeuchi it would have been obvious to modify the putter of Boom to have the alignment lines being indicia and taking up the entire length, width and center of a grip top flat surface in order to

minimize the number of parts needed for a grip and in order to be more visually visible for a golfer by using the entire surface for the alignment indicia. As such for an oval shaped grip a first alignment line will be longer than a second alignment line.

9. Claims 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boom in view of Radakovich and Takeuchi as applied to claims 6-7, 9-12, and 14-15 above, and further in view of Eberle or Dishner.

Boom lacks a handle extending at least half of the overall length of the club from the head to the upper end of a shaft. Eberle discloses an elongated handle having a generally oval, cross-sectional shape including rounded front and rear edges (Fig. 3), an elongated axis of an oval, cross-sectional shape being perpendicular to the plane of the ball striking face (Col. 3, Lns. 55-57), and a handle having a length approximately half the overall length of the golf club (Fig. 1) in order to have a pendulum type putter (Col. 1, Lns. 7-32). Dishner discloses an elongated handle having a generally oval, cross-sectional shape including rounded front and rear edges (Fig. 3), and a handle having a length approximately half the overall length of the golf club (Figs. 5-6) in order to have a length adaptable to a wide variance of personal stances and physiognomy (Col. 4, Lns. 13-14). In view of the patents of Eberle or Dishner it would have been obvious to modify the putter of Boom to have a handle extending at least half of the overall length of the club from the head to the upper end of a shaft in order to have a length adaptable to a wide variance of personal stances and physiognomy.

10. Claims 11-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Radakovich and Takeuchi.

Radakovich discloses a sighting device placed on a flat surface of a grip end (Fig. 4) having a length dimension being perpendicular to a first plane of a ball striking face, an alignment device on an upper edge with a first alignment line in a direction perpendicular to a first plane of a ball striking face, a second alignment line being perpendicular to a first alignment line, parallel to a ball striking face and intersecting a first alignment line at a center of a grip plugging a vent hole (Col. 5, Lns. 34-39), a flat upper surface (Fig. 4) and a handle and shaft being able to be used for a putter (Fig. 2) in order to improve accuracy (Col. 1, Lns. 7-10) by improving alignment and control of a face (Col. 1, Lns. 35-37).

Radakovich lacks an alignment lines being indicia. Takeuchi discloses alignment lines for grip positioning on a shaft being on a flat surface of a grip and being indicia (Fig. 5, Col. 4, Lns. 11-16) filling up the entire length and width of a grip top flat surface except the center (Fig. 5). In view of the patent of Takeuchi it would have been obvious to modify the club of Radakovich to have the alignment lines being indicia and taking up the entire length, width and center of a grip top flat surface in order to minimize the number of parts needed for a grip and in order to be more visually visible for a golfer by using the entire surface for the alignment indicia.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Radakovich in view of Takeuchi as applied to claims 11-12 and 15 above, and further in view of Eberle or Dishner.

Radakovich lacks a handle extending at least half of the overall length of the club from the head to the upper end of a shaft. Eberle discloses a handle having a length approximately half the overall length of the golf club (Fig. 1) in order to have a pendulum type putter (Col. 1, Lns. 7-32). Dishner discloses a handle having a length approximately half the overall length of the golf club (Figs. 5-6) in order to have a length adaptable to a wide variance of personal stances and physiognomy (Col. 4, Lns. 13-14). In view of the patents of Eberle or Dishner it would have been obvious to modify the club of Radakovich to have a handle extending at least half of the overall length of the club from the head to the upper end of a shaft in order to have a length adaptable to a wide variance of personal stances and physiognomy.

### ***Response to Arguments***

12. The argument that Radakovich is improper due to being alignment system for a golf swing and not of a putting stroke is disagreed with. Clearly a putting stroke is a golf swing and alignment lines on an end of a grip assisting a club swung fast would benefit a club swung slow. The argument that Radakovich is improper due to Radakovich intending to be adjustable where applicant's lines are fixed is disagreed with. Clearly throughout the art of golf as shaft length, lie angles, loft angles etc... adjustable features

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are exchangeable with fixed features. If the adjustable feature is not needed to be adjusted than it is beneficial to make the feature permanent so it will not be inadvertently changed. Plus this is why Takeuchi was used to show a visually alignment marking at an end of a grip being fixed in the form of indicia. The argument that Radakovich is improper due to Radokovich having no desire to have an alignment line lie flat on the butt end of a grip is disagreed with. Clearly the alignment device of embodiment in figure 5 has indicia on a flat face of a device attached to a butt end of a grip. Clearly an alignment indicia can be part of the grip and the surface can be made to have the angled flat surface as necessary. The argument that Radakovich device must be adjusted to taken into consideration the level of the playing surface before each swing is not understood. The examiner could not find where Radakovich discusses adjusting the device in this manner. The argument that is it improper to use the reference of Takeuchi since all the lines do not intersect and having them to intersect would destroy the reference of Takeuchi is disagreed with. The examiner was not using the method of forming alignment lines for grip installation of Takeuchi but using the intersecting alignment lines of Radakovich for swing alignment. Takeuchi was used to show a different way to make alignment lines. The argument that it is improper to combine Radakovich with Takeuchi since neither discuss alignment lines taking up the entire length, width and center of a grip top surface is disagreed with. The examiner believes the combination does. Takeuchi discloses alignment lines being 360 degrees around a grip axis. Radakovich discloses alignment lines from a very center of a club end to near the outer edge (Figs. 4-5). Together the references would suggest

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alignment indicia being 360 degrees around a grip axis and lines from a very center of a club end to an outer edge. The argument that combining the references of Radakovich and Takeuchi is improper due to both being concerned with different problems is disagreed with. Both are concerned with using a visual alignment mechanism at the end of a club. Both are concerned with an angular perspective a person has when looking at the end of a club. The argument that the references of Cacicedo, Bloom, Eberle and Dishner are improper due to not claiming the handle shape is disagreed with. All grips have a cross section shape, a cross section shape along a length, and a total length for a grip. Together these references show these features and the references and the examiner provided motivation of why to combine them. Due to the new double patenting and 102 rejections this action is not made final.

### **Conclusion**

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 29 July 2005



**STEPHEN BLAU**  
PRIMARY EXAMINER